

REMARKS

As a preliminary matter, Applicant's attorney, Gary J. Speier (Reg. No. 45,458), thanks the Examiner for the courtesy extended during the telephone interview on 28 April 2004. During the interview, Applicant's attorney alerted the Examiner to the discrepancy in the Office Action dated 25 March 2004. Specifically, Applicant's attorney indicated that page 1 of the Office Action stated that claims 1-65 were rejected (see, Disposition of Claims), while claims 56-57 and 59-63 were not rejected to or objected to within the Detailed Action of the Office Action. During the telephone interview, the Examiner stated that at page 5, item 7, there was a typo and the Office Action should read "claims 1-65 are rejected under 35 U.S.C. 103(a)."

During the telephone interview, Applicant's attorney and the Examiner discussed the specific claim amendments made herein. The Examiner indicated that he would consider the claims amendments and attorney arguments, in light of the cited references. Applicant's attorney also indicated that such claim amendments were being made to facilitate prosecution. Applicant's attorney requested that should the Examiner maintain the rejection, or identify other art that the Examiner believes is relevant for patentability purposes, that the Examiner contact Applicant's attorney before issuing a subsequent office action. This was requested so that Applicant would be given an opportunity to request an interview with the Examiner prior to the issuance of a subsequent office action. The Examiner agreed. Applicant's Attorney believes this is a complete and accurate summary of the interview. If the Examiner believes this is inaccurate or incomplete, Examiner is invited to make any such comments or remarks on the record in the next correspondence.

This is in response to the Office Action mailed on March 25, 2004, and the references cited therewith.

No claims are amended, claims 1-97 are canceled, and claims 98-130 are added; as a result, claims 98-131 are now pending in this application. Support for new claim 98 can be found, e.g., at claim 1, 22, 32, 47, 59 and 64 as originally filed. Support for new claims 99-111 can be found, e.g., at claims 5-17, respectively, as originally filed. Support for new claims 112-115 can be found, e.g., at claims 23-26, respectively, as originally filed. Support for new claims 116-118 can be found, e.g., at claims 33-35, respectively, as originally filed. Support for new claims 119-121 can be found, e.g., at claims 36-38, respectively, as originally filed. Support for

new claim 121 can be found, e.g., at page 11, line 21 to page 12, line 16. Support for new claims 122-124 can be found, e.g., at claims 41-43, respectively, as originally filed. Support for new claims 125-127 can be found, e.g., at claims 59-62, respectively, as originally filed. Support for new claim 128 can be found, e.g., at claim 63 as originally filed. Support for new claim 129 can be found, e.g., at claim 65 as originally filed. Support for new claim 130 can be found, e.g., at claim 63 as originally filed. As such, no new matter has been added by way of this amendment.

Affirmation of Election

Restriction to one of the following claims was required:

As provisionally elected by Applicants representative, Gary A. Speier, on March 22, 2004, Applicant elects to prosecute the invention of Group I, claims 1-65 (now claims 98-130).

The claims of the non-elected invention, claims 66-97, are hereby canceled. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

35 USC §112 Rejection of the Claims

Claims 39, 40, 58, 64, and 65 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim amendments made herein obviate the rejection under 35 U.S.C. 112, first paragraph. Specifically, the claims do not recite the terms "FUSABOND" or "CELLPASTE."

35 USC §103 Rejection of the Claims

Claims 1-65 were rejected under 35 USC §103(a) as allegedly being unpatentable over the combined teachings of the Kozma patents (US Pat Nos. 6,221,928; 6,242,503; and 6,262,137); in view of the Rowland patents (US Pat Nos. 4,692,475 and 4,655,962); and US Pat No. 4,085,239. In light of the claim amendments and remarks provided herein, Applicant respectfully traverses this rejection.

US Pat Nos. 6,221,928; 6,242,503; and 6,262,137 ("Kozma patents")

Neither of the Kozma patents, alone or in combination, disclose or suggest the use of a natural rubber to manufacture a foamed cushion. Additionally, neither of the Kozma patents alone or in combination, disclose or suggest the use of stearic acid (i.e., the combination of zinc oxide and stearic acid) to manufacture a foamed cushion.

US Pat Nos. 4,692,475 and 4,655,962 ("Rowland patents")

Neither of the Rowland patents, alone or in combination, disclose or suggest the use of a polymeric adhesion modifier to manufacture a foamed cushion. Additionally, neither of the Rowland, alone or in combination, disclose or suggest the use of dicumyl peroxide to manufacture a foamed cushion.

US Pat No 4,085,239

The '239 patent does not disclose or suggest the use of natural rubber to manufacture a foamed cushion. The '239 patent does not disclose or suggest the use of ethylene-vinyl acetate (EVA) copolymer to manufacture a foamed cushion. The '239 patent does not disclose or suggest the use of azodicarbonamide (AC) to manufacture a foamed cushion. The '239 patent does not disclose or suggest the use of a polymeric adhesion modifier to manufacture a foamed cushion. The '239 patent does not disclose or suggest the use of dicumyl peroxide to manufacture a foamed cushion. While the '239 patent does disclose the use of zinc oxide or stearic acid (see, col. 6, lines 32-44), the '239 patent does not disclose or suggest the use of a combination of zinc oxide and stearic acid, to manufacture a foamed cushion.

No Prima Facie Case of Obviousness

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988) and *In re Piasecki*, 745 F.2d at 1472, 223 U.S.P.Q. at 788. If the Examiner does not establish a prima facie case, the applicant is under no obligation to submit evidence of non-

obviousness. M.P.E.P. § 2142. To establish a prima facie case of obviousness, three criteria must be met.

First, the reference (or references) relied upon must teach or suggest all the limitations of the claims. See *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

Second, the reference (or references) relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. See *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Skinner*, 2 U.S.P.Q.2d 1788, 1790 (Bd. Pat. App. & Int. 1986).

Third, the proposed modification of the reference (or references) relied upon must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. In other words, a hindsight analysis is not allowed. See *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209, 18 U.S.P.Q.2d 1016, 1023 (Fed. Cir. 1991); *In re Erlich*, 3 U.S.P.Q.2d 1011, 1016 (Bd. Pat. App. & Int. 1986).

No Suggestion or Incentive to Modify or Combine References

The Examiner has not met the burden to show sufficient motivation for one of ordinary skill in the art at the time of invention to take any one of the following steps, let alone the following combination:

(1) selecting natural rubber from the list of "expandable materials" in the Rowland patents (see, the '475 patent, col. 6, lines 8-23; and the '962 patent, col. 6, lines 7-21);

(2) selecting ethylene-vinyl acetate (EVA) from the list of "polyolefinic polymers" in the Kozma patents (see, the '503 patent, col. 5, line 31-63; the '137 patent, col. 5, lines 30-61, and the '928 patent, col. 7, line 50 to col. 9, line 15);

(3) selecting azodicarbonamide (AC) from the list of chemical foaming agents in the Kozma patents (see, the '928 patent, col. 12, lines 33-67; the '137 patent col. 9, lines 7-45; and the '503 patent, col. 9, lines 9-46, respectively); or selecting azodicarbonamide (AC) from the blowing agent composition in the Rowland patents (see, Abstract);

(4) selecting a polymeric adhesion modifier (e.g., FUSABOND) from the list of maleic anhydride-grafted materials in the Kozma patents (see, '928 patent col. 11, lines 26-62; '137 patent col. 8, lines 4-37; and '503 patent col. 8, lines 6-39); and

(5) selecting dicumyl peroxide from the list of cross-linking agents in Kozma patents (see, '928 patent col. 13, line 19 to col. 14, line 41); and

(6) selecting the combination of zinc oxide and stearic acid from Examples 12-14 in the Rowland patents (see, '962 patent col. 10, lines 24-5, "Master-batch -1").

References Teach Away from the Proposed Modification or Combination

Motivation may be lacking when the state of the art at the time of the invention in question was discovered pointed researchers in a different direction than the inventor proceeded. Indeed, the Federal Circuit has repeatedly recognized that proceeding contrary to the accepted wisdom in the art represents "strong evidence of unobviousness." *In re Hedges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986); *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552, 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

One skilled in the art, upon reading the Kozma patents, would not be motivated to employ natural rubber in the manufacture of the foamed article described therein (i.e., to modify the disclosure of "polyolefinic polymers"). The Kozma patents provide a detailed list of classes of compounds, and specific compounds, that serve as polyolefinic polymers (see, the '928 patent, col. 2, lines 7-15 and col. 7, line 55 to col. 10, line 39). Included within this disclosure is ethylene-propylene rubber (i.e., a synthetic rubber). Neither natural rubber itself, nor any specific natural rubbers are disclosed or suggested therein. Additionally, in the "Background of the Invention" section of the Kozma patents, the patentee suggests that employing natural rubber may be detrimental for cost and/or quality purposes. In doing so, the Patentee states:

[N]atural rubber latex foamed articles provide soft materials for body contact and the application of cosmetics ('928 patent, col. 1, lines 15-16). ... A variety of polyolefinic polymers may generally be used for each application ('928 patent, col. 1, lines 26-27). However, a polymer which may be desirable for one property, such as cost, may provide a lower quality end product, such as a foamed article with significant voiding ('928 patent, col. 1, lines 29-30).

As such, one skill in the art, upon reading the complete disclosure of the Kozma patents, would not be motivated to modify the disclosure therein, to arrive at the presently claimed invention (i.e., to employ natural rubber in the manufacture of the foamed article described therein).

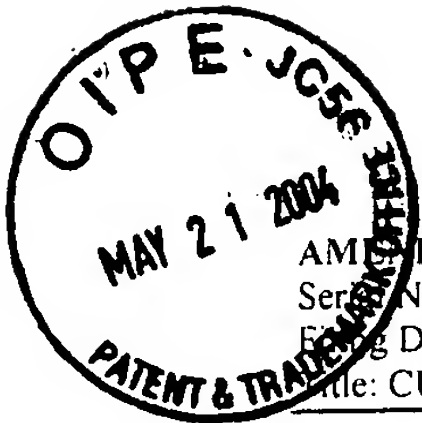
References Provide No Reasonable Expectation that the Proposed Modifications will Succeed

Beyond looking to the prior art to determine if it suggests doing what the inventor has done, one must also consider if the art provides the required expectation of succeeding in that endeavor. See *In re Dow Chem. Co. v. American Cyanamid Co.*, 837 F.2d at 473, 5 U.S.P.Q.2d at 1531 ("Both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure."). "Obviousness does not require absolute predictability, but a reasonable expectation of success is necessary." *In re Clinton*, 527 F.2d 1226, 1228, 188 U.S.P.Q. 365, 367 (C.C.P.A. 1976).

The Examiner has not met the burden to show why one of skill in the art would reasonably believe that modifying the disclosure in Kozma (i.e., to employ natural rubber, as opposed to the polyolefinic polymers described therein), while employing a combination of zinc oxide and stearic acid, would provide a foam cushion with suitable properties.

Rebutting the Prima Facie Conclusion of Obviousness

Applicant respectfully points out that even if the Examiner is successful in establishing a prima facie conclusion of obviousness, Applicant can rebut such a prima facie case of obviousness by presenting comparative test data showing unexpected results. See *In re Dillon*, 919 F.2d at 692-93, 16 U.S.P.Q.2d at 1901; *In re Chupp*, 816 F.2d 643, 646, 2 U.S.P.Q.2d 1437, 1439 (Fed. Cir. 1987); *In re Merck*, 800 F.2d 1091, 1098, 231 U.S.P.Q. 375, 380 (Fed. Cir. 1986); *In re Payne*, 606 F.2d 303, 315-16, 203 U.S.P.Q. 245, 256 (C.C.P.A. 1979). For example, a product covered by the present claims has more strength, per density, than the product described in the Kozma patents.



AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 10/061672

Filing Date: February 1, 2002

Title: CUSHION AND METHOD OF MAKING AND USING THE SAME

Page 13

Dkt: 1499.001US1

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 359-3261 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

BINH VAN HOANG ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 359-3261

Date 5/18/04

By [Signature]
Gary J. Speier
Reg. No. 45,458

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18th day of May, 2004.

Amy Moriarty
Name

[Signature]
Signature